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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,260

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EXAMINER

SULLIVAN, DANIELLE D

ART UNIT

PAPER NUMBER

1616

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/575,260	<b>Applicant(s)</b> TSUCHIKAWA ET AL.	
	<b>Examiner</b> DANIELLE SULLIVAN	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/04/2009 has been entered.

### ***Response to Arguments***

Applicant argues that Yoneyama, alone or in combination with Suzuki fail to teach a method of preparing a cosmetic utilizing a ultraviolet protective preparation. Applicant's arguments, filed 8/04/2009 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of applicant's amendment.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-26 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the

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steps. See MPEP § 2172.01. The omitted steps are: what the ultraviolet protective preparation is added to.

The claim recites “a method of producing a cosmetic comprising a step of adding 3 to 95% by weight of an ultraviolet preparation”. It is unclear if the preparation is added to the skin, the eyelash, the nail or a cosmetic composition. Hence, the metes and bounds of the claim cannot be deciphered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14-16, 18-21, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baba et al. (US 5,849,272) in view of Bagdi et al. (US 2002/0160023).

### **Applicant's Invention**

Applicant claims a method of producing a cosmetic comprising a step of adding 3 to 95% by weight of an ultraviolet preparation comprising 0.2-3% by weight an ester compound, 52-79.9% by weight of an ester oil and 15 to 45% by weight of an ultraviolet protective powder, wherein the ester compound is glycerin behenate eicosanoate (Numcort HK-G) and the ester oil is selected from polyols selected from glycerin, pentaerythritol and one or more saturated straight-chain carboxylic acids having a

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monovalent carboxyl group and/or saturated branched carboxylic acids having a monovalent carboxyl group. Claim 15 further limits the cosmetic to being selected from lotions, creams, ointments, foundations, lipsticks, mascaras, eyeshadows, eyebrows, nail enamels and cheek colors. Claims 16 and 20 specifies the ester compound being selected from neopentyl glycol dicaprate, glyceryl tri-2-ethylhexanoate and pentaerythritol tetra-2-ethylhexanoate. Claim 16 and 21 specify the uv protective powder is selected from titanium dioxide, iron-containing titanium dioxide and zinc oxide. Claim 18 specifies the preparation comprises the ester compound 0.4-2%, ester oil 57.1-74.8% ultraviolet protective powder 24.8-39.9%. Claim 19 specifies the ester oil has a viscosity of 4-100 mPa\*s at 20°C. Claims 25 and 26 are directed to inherent properties of the formulation and do not contribute to patentable weight.

**Determination of the scope and the content of the prior art**

**(MPEP 2141.01)**

Baba et al. teach an ultraviolet absorbing composition (abstract). The formulation has improved stability, feel of use (column 1, lines 13-17). The uv absorber 4-tert-butyl-4'-methoxy dibenzoylmethane together with a polyhydric alcohol fatty acid ester or disclosed (column 1, lines 47-56). The composition may be formulated as a lotion, cream, foundation, lip rouge, eye or hair product (column 4, lines 11-24). Oils include pentaerythritol tetra-2-ethylhexanoate, glyceryl tri-2-ethylhexanoate and neopentyl glycol dicaprate (column 6, lines 52-57). The oily ingredients are not restricted but preferably range from 0.5-60% weight the whole composition. The UV absorber preferably comprises 0.1 to 20% the formulation (column 2, lines 30-46). The

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UV absorbers titanium dioxide and zinc oxide are envisaged in Examples 7 and 8. The ester oil pentaerythritol tetra-2-ethylhexanoate and glyceryl tri-2-ethylhexanoate are envisaged in Examples 1-5, 3-1, 3-2, 3-3, 1 and 2.

**Ascertainment of the difference between the prior art and the claims**

**(MPEP 2141.02)**

Baba et al. does not teach the specific ester compound. It is for this reason that Bagdi et al. is joined.

Bagdi et al. teach a gelled cosmetic composition comprising an oil phase and external phase gelled by a condensation product of glycerine and a long chain fatty acid (abstract). The gellant preferably comprises behenate and eicosanoate [0009]. Glyceryl behenate/eicosadioate in an amount of 0.25 to 25% is preferred [0010]. It is desirable to provide moisturizers selected from esters to enhance moisture capacity [0012]. The formulations may also incorporate actives selected from sunscreens [0016]. Examples utilize 1-3% of the ester compound [0019]. The base is useful for a wide range of cosmetic products which are stable and provide an unusual level of moisturization to the skin [0003-0004].

Baba et al. does not teach the ultraviolet protective powder may range from 24.8-39.9% of the total formulation. However, Baba et al. teach that compounding amounts are not restricted to 0.1 to 20% and is selected according an expected ultraviolet absorbing effect (column 2, lines 38-42).

**Finding of prima facie obviousness**

**Rationale and Motivation (MPEP 2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Bada et al. and Bagdi et al. to use the ester compound glyceryl behenate/eicosadioate. One would have been motivated to use glyceryl behenate/eicosadioate because Bagdi et al. teach that it is a gellant that provides stability and unusual moisturization to a variety of cosmetic products.

Deleted: Badi

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Bada et al. and Bagdi et al. to use the ultraviolet protective powder from 24.8-39.9% of the total formulation. One would have been motivated to manipulate ranges during routine experimentation to discover the optimum or workable range since the Baba et al. teach the range is altered based on desired ultraviolet absorbing effect. Therefore, one would have been motivated to use the appropriate amount of ultraviolet protective powder needed to impart a specific absorbing effect.

Deleted: Badi

Claims 17 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baba et al. (US 5,849,272) in view of Bagdi et al. (US 2002/0160023) and in further view of Miyoshi et al. (US 5,968,531).

#### **Applicant's Invention**

Applicant claims a method of producing a cosmetic comprising a step of adding 3 to 95% by weight of an ultraviolet preparation comprising 0.2-3% by weight an ester compound, 52-79.9% by weight of an ester oil and 15 to 45% by weight of an ultraviolet

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protective powder, wherein the ester compound is glycerin behenate eicosanedioate (Numcort HK-G) and the ester oil is selected from polyols selected from glycerin, pentaerythritol and one or more saturated straight-chain carboxylic acids having a monovalent carboxyl group and/or saturated branched carboxylic acids having a monovalent carboxyl group. Claims 17 and 22 further add lecithin to the composition. Claim 23 specifies the ratio of lecithin to the total composition is 0.0001:1 to 0.05:1. Claim 24 specifies that the lecithin is hydrogenated.

**Determination of the scope and the content of the prior art****(MPEP 2141.01)**

The teachings of Baba et al. and Bagdi et al. are addressed in above 103(a) rejection.

**Ascertainment of the difference between the prior art and the claims****(MPEP 2141.02)**

Baba et al. and Bagdi et al. do not teach that lecithin is added. It is for this reason that Miyoshi et al. is joined.

Miyoshi et al. teach that hydrogenated lecithin is a surface treating composition used to impart desired characteristics to composite powders in conjunction with metallic soap (column 3, line 62-67). The agents aid in a desired aesthetic feel, pressability and improved transparency on the skin (column 4, lines 4-7). An example of a compressed powder foundation comprising 7% hydrogenated lecithin treated mica is disclosed (Example 3).

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**Finding of prima facie obviousness****Rationale and Motivation (MPEP 2142-2143)**



It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Baba et al., Bagdi et al. and Miyoshi et al. to further include hydrogenated lecithin in the cosmetic compositions. One would have been motivated to include lecithin because Miyoshi teaches that adding hydrogenated lecithin to composite powders improve their aesthetic feel and transparency on the skin.

### ***Response to Amendment***

The declaration under 37 CFR 1.132 filed 8/04/2009 has been considered but not convincing in view of the shift in claims from a composition to a method of making. Additionally, new references have now been cited.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bianchi et al. (WO 02/11691).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle Sullivan whose telephone number is (571) 270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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